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Peter M Ullman
WOODCOCK WASHBURN KURTS
MACKIEWICZ & NORRIS LLP
One liberty Place- 46th Floor
Philadelphia, PA 19103

EXAMINER

CHRISTMAN, KATHLEEN M

ART UNIT	PAPER NUMBER
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3713

12

DATE MAILED: 03/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/901,797

Applicant(s)

DRISCOLL ET AL.

Examiner

Kathleen M Christman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/22/2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 1-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 12-40 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

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DETAILED ACTION

In response to the amendment filed 12/22/2003, claims 1-11 remain withdrawn from consideration; claims 12-29 and newly added claims 30-40 are pending.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 1-23 and 30-40 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The newly added limitation "wherein a computing device at which said test questions are delivered is not communicatively connected to said first server during the delivery" is not enabled by the specification as originally filed. The examiner believes that the "computing device" is intended to be the "Testing Station", element 218. The network connections of which appear to be best described starting at page 12 line 1 through page 13 line 5. There is nothing in this session stating that the test station must be disconnected from the first server during the time of test delivery. Further new claims 30-40 are wholly unsupported by the specification as originally filed. The examiner has been unable to locate any reference an update period, or statements regarding when the test center will and will not be in communication with the first server. Although the applicant has reference pages 6-15 as providing support for these features the examiner has been unable to determine which features of this section the applicant intends to rely upon for the newly added claims.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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2. Claims 14 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 14 and 15 contains the trademark/trade name Java Enterprise, ThinWeb and JRUN V3.0. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a specific programming platform and, accordingly, the identification/description is indefinite.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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3. Claims 12-17, 21, 22, 30-33 and 37-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Richard et al (US 6162060). Richard et al teaches a method for the operation of a educational system which includes the steps of: establishing a communication link with a first server (the main computer) remote from a test center (the local server); transmitting to said first server via said communication link, first information indicative of a version of testing materials installed at said testing center; receiving, from said first server via said communication link, first testing materials comprising one or test questions (see col. 9: 31-36); and electronically delivering said test questions to an examinee at said testing center, see col. 4: 55-65. The act of transmitting comprising transmitting a test center record indicative of a status of said testing center, said status including an identity of testing materials installed at said testing center (claim 16) and transmitting, to said first server, property information indicative of software installed at said testing center (claim 17) is taught at col. 6: 58-12. Regarding claim 21, the system of Richard et al includes a test delivery management module which receives testing materials, said test delivery management module having a database which stores the received testing materials, said test delivery management module further hosting first client server logic which retrieves the testing material from said database (Figure 4, element 403) and a testing-station module which receives the testing materials from said test-delivery management module in a manner controlled by said first client-server logic, said testing-station module having a user interface which presents the testing materials to a candidate in a manner controlled by said first client server logic (the student workstation under control of the execution files). The main computer (the first server) delivers information a local server (the testing station) which is connected to the student workstation (the computing device at the test center). There is no active communication between the computing device and the first server during delivery of the course, and thus the computing device at which said test questions are delivered is not communicatively connected to said first server during the delivery of the questions (the newly added limitation of claims 12 and 21). The communication with the server and the main computer is not always active, and is only active once per period (at the beginning of the session when the student first requests the course), claims 30, 32 and similar language of claims 37-39. Regarding claims 31, 33 and 40, assuming that the teacher

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does not update the course multiple times a day, the system will implicitly only have to retrieve information from the main server once per day.

Richard et al does not specifically teach that the communication link is established over a wide area network (claims 12 and 21), that the network is the Internet (claim 13), that the establishing comprising using a Java Enterprise Service (claim 14), where the Java Enterprise Service is either ThinWeb or JRUN v3.0 (claim 15) and the general concept of using java (claim 22). It is the examiner's position that one of ordinary skill in the art recognizes that any LAN based system (such as Richard et al) may easily be modified to be WAN based system, the internet of which is the most common WAN and as such it would be obvious to one of ordinary skill in the art to modify the Richard et al system in this manner. Regarding claims 14, 15, and 21, Richard et al teaches "it is of primordial importance that the computers, which are of differing manufacture may communicate with each other, and any software products which rely on distributed tasks over the various computers in the network should be so constructed as to make the difference between the various kinds of computers in the network moot" at col. 4: 13-19. It is of common knowledge and skill in the art that Sun Microsystems developed and marketed all of its Java packages to be platform independent. It would be obvious to one of ordinary skill in the art to use a java software package to develop the method and system of Richard et al so as to provide the platform independent requirements that the invention calls for.

4. Claims 18-20, 23-29 and 34-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Richard et al (US 6162060) in view of Cook et al (US 2002/0168621 A1).

Regarding claims 18-20,23 and 34-36, Richard et al teaches all aspects of the claimed invention as shown above except receiving using a transport protocol and at least one other protocol that packages information according to said transport protocol, data indicative of said test center installation status (claim 18), packaging said first information in one or more data structures according to a first protocol and sending said one or more data structures to said first server via said wide-area networking using a transport protocol different from said first protocol (claim 19) where the transport protocol is Hypertext Transport Protocol (HTTP); cryptographic certificate authentication and revocation (claims 34-36).. Nor

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does Richard et al describe the protocol engine as in claim 23. Cook et al teaches how encryption algorithms function in paragraphs 136-138. It is the examiner's position that this functionality is the same as that described by claims 18 and 19. The examiner takes OFFICIAL NOTICE that authentication certificates for secure communication and data transfer are old and well-known in the art of networking and data transfer. Such protocols are commonly implanted to ensure the security of any information. It would have been obvious to one of ordinary skill in the art to implement such a method with either the Cook et al or Richard et al patent so as to ensure that the test questions remained confidential. Cook et al does not specifically mention the use of HTTP, however HTTP is a known industry standard and it would thus be obvious to implement the system using HTTP.

Regarding claims 24-29 Richard et al teaches a system similar to that of the claimed protocol engine, including: a service module which generates service data that provides a service to the testing center; a service authorization module which is communicatively coupled to said service module, which receives the service data, and which engages in an authorization inquiry with the testing center to determine whether the test service center may perform said service for said testing center, and which forward said service data to the testing center according to a result of said authorization inquiry (col. 4: 49-54), claim 24, including seeing if center is authorized to receive the materials, as in claim 29, where the materials are testing material (see col. 9: 31-36), claim 27. The system further includes provisions for updating the version of the materials (col. 6:59-64), as in claim 29.

Richard et al does not teach the specific use of a wide area network (claim 24), encryption modules including an authentication module (claim 24), where the authentication protocol includes a challenge response system (claim 26), and the use of a transport protocol namely Hypertext transport protocol (HTTP) or secure Hypertext Transport Protocol (claim 25). Cook et al teaches how encryption algorithms function in paragraphs 136-138. It is the examiner's position that this functionality is the same as that described by claims 24 and 26. For the reasons given above it would have been obvious to incorporate the authentication and security protocols so as to maintain the authenticity and security of the exam questions. Cook et al does not specifically mention the use of HTTP, however HTTP is a known industry standard and it would thus be obvious to implement the system using HTTP.

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Response to Arguments

Applicant's arguments filed 12/22/2003 have been fully considered but they are not fully persuasive.

35 USC §112, second paragraph

In view of the amendments and arguments on page 9 of the above response the rejection of claims 12, 13 and 16-20 under 35 USC §112, second paragraph have been withdrawn.

However, the rejection of claims 14 and 15 is held. MPEP section 2173.05(u) reads:

The presence of a trademark or trade name in a claim is not, per se, improper under 35 U.S.C. 112, second paragraph, but the claim should be carefully analyzed to determine how the mark or name is used in the claim. It is important to recognize that a trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. See definitions of trademark and trade name in MPEP §608.01(v). A list of some trademarks is found in Appendix I. **If the trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of the 35 U.S.C. 112, second paragraph. Ex parte Simpson, 218 USPQ 1020 (Bd. App. 1982).** The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. In fact, the value of a trademark would be lost to the extent that it became descriptive of a product, rather than used as an identification of a source or origin of a product. Thus, the use of a trademark or trade name in a claim to identify or describe a material or product would not only render a claim indefinite, but would also constitute an improper use of the trademark or trade name.

If a trademark or trade name appears in a claim and is not intended as a limitation in the claim, the question of why it is in the claim should be addressed. Does its presence in the claim cause confusion as to the scope of the claim? If so, the claim should be rejected under 35 U.S.C. 112, second paragraph.

The trademarks/trade names referred to in the claim are clearly meant to limit the claim.

Applicant has stated that "there are certain properties that are generally associated with a particular source" and "such properties are associated with a source depends on what would be understood by one of ordinary skill in the art reading the claims". The examiner agrees that generally speaking one of ordinary skill in the art may associate a particular property with a product, for example when ones thinks of Clorox one commonly thinks of chlorine bleach. However, the properties associated with the product may vary over time. For the above example, Clorox markets several non-chlorine bleach products under the same name. Similarly the features of a particular software program or package may change over time, i.e. Microsoft Windows. A trademark or trade name, regardless of how specific, does not refer to particular

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properties associated with that product and cannot be used to do so. As such, the rejection is deemed proper and maintained.

Claims 1-23 and 30-40

The examiner has addressed each of these limitations in at least one of the rejections above.

Claims 24-29, 35 USC §103(a) Richard et al in view of Cook et al

Applicant has argued that the examiner has failed to show the various "modules" with the interrelationships claimed. Applicant has not provided any arguments directed to any supposed flaws in the examiner's logic of equating these modules to the cited sections of Cook et al and Richard et al. The modules of applicant's invention are merely software components or computer routines and are not described in the specification as anything other than. Concerning the statement "the examiner has not addressed the interrelationship features and thus has not provided a full explanation", the examiner notes that the interrelationship features were addressed in the prior rejection and that one of ordinary skill in the computer programming arts may could readily recognize each limitation. The examiner is not required to produce a reference which discloses the invention in the same terms used by the applicant. Applicant further argues the that the examiner has not shown a "protocol engine". However, the term only appears in the preamble of the claim. A preamble term that fails to breath life and meaning into the claims since it is not 'essential to point out the invention defined by the claim'. *Kropa v. Robie*, 88 USPQ 478, 481 (CCPA 1951). Further, the term does not limit the structure of the claimed device. *In re Stencel*, 4 USPQ2d 1071 (Fed. Cir. 1987). Finally, the term recites an intended use of structure where the claim body does not depend on the preamble for completeness such that the structural limitations stand-alone. *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976). Therefore the structural limitations of the claims are interpreted in and of themselves. Therefor the rejection of the claims is deemed proper and the rejection is maintained.

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Further comments

The examiner takes notice that the applicant has not traversed the common knowledge statements made in the previous rejections. As such these statements are now considered to be taken as admitted prior art, see MPEP §2144.03.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

This application contains claims 1-11 drawn to an invention nonelected without traverse in Paper No. 8. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen M Christman whose telephone number is (703) 308-6374. The examiner can normally be reached on M-F 7:30-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa Walberg can be reached on (703) 308-1327. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Kathleen M. Christman


Teresa Walberg
Supervisory Patent Examiner
Group 3700